

DOCKET NO.: ABTT-0258/B010690
Application No.: 10/028,831
Office Action Dated: September 23, 2003

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS/ARGUMENTS

Applicants acknowledge with appreciation the Examiner's indication that the drawings filed in this application are acceptable for examination purposes.

Claims 1-16, 18-21, and 23-26 are pending in the present application. Claims 1-16, 18-21, and 23-26 have been rejected.

Claims 1-16, 18-21, and 23-26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Poyser et al. (U.S. Patent No. 4,654,806). It is respectfully submitted that claims 1-16, 18-21, and 23-26 are allowable over the art of record for the reasons set forth below.

Claims 1, 7, 13, 18, and 23 include features that are neither disclosed nor suggested by the cited reference, namely, as represented by claim 1:

a user-changeable transformer test sequence comprising a plurality of user-selected tests and instructions in a user-defined order of execution....

A transformer test sequence is user-changeable and comprises user-selected tests and instructions. The tests and instructions are set to execute in a user-defined order of execution. As acknowledged by the Examiner, "Poyser et al. fail to teach a user-changeable test that comprises a plurality of user-selected tests and instructions in a user-defined order of execution." (Office Action, section 4). The Examiner then states that

"all of the tests that the users are able to select are well known to those of ordinary skill in the art. When performing a test on any device, including transformers, a user must decide what types of test to run and in what order they are run. The step of automating this test sequence creation via prompts and menus does not impart non-obviousness to an invention." (Office Action, section 5).

The Examiner cites MPEP 2106, *Dann v. Johnston*, and *In re Venner* as support. It is respectfully submitted that the Applicant's invention is not merely automating a test sequence creation, and furthermore, that MPEP 2106, *Dann v. Johnston*, and *In re Venner* do not apply in this case.

In accordance with the present invention, a user can change the order of execution of tests and instructions within a test sequence or the order of pre-existing sequences. This provides the user with, for example, the option of specifying those test instructions or test sequences most likely to cause test failure followed by sequences less likely to cause failure (application as originally filed, page 7, lines 6-11). These features have never been provided before Applicant's invention. As described in Applicant's "Background Of The Invention", transformers are typically tested at a manufacturer's testing facility, using a fixed sequence of test instructions. Applicant is not merely automating the creation of test sequences, but is providing the ability to create, modify, and adjust test sequences so that a user can optimize the tests to his particular needs.

The only suggestion of this feature is Applicant's own teaching. Thus, Applicant respectfully submits that the Examiner is practicing hindsight reconstruction of Applicant's invention, a practice heavily cautioned against by the Federal Circuit. At the time of Applicant's invention, a great need existed for a transformer testing system in which a user can change the order of execution of tests and instructions within a test sequence or the order of pre-existing sequences. Applicant provided a solution that is nowhere addressed in the prior art of record.

The claimed invention may seem simple. Nevertheless, "the simplicity of new inventions is often the very thing that is not obvious before they are made The fact that the invention seems simple after it is made is not determinative of the question of obviousness." *In re Van Wanderhorn, Worthley, and Conolli*, 154 USPQ 20, 24 (CCPA 1967). Unfortunately, the Office Action has converted the simplicity of the claimed invention into obviousness – when the simplicity of the invention is the very thing that had eluded the art.

The Examiner is relying on the knowledge of persons of ordinary skill in the art to modify the invention disclosed by Poyser by automating the test sequence generation process (Office Action, page 3, section 5). However, it is unclear to Applicant how Poyser could be modified by one of ordinary skill in the art to provide Applicant's invention, without frustrating the purposes of Poyser. Poyser describes a method and apparatus for monitoring transformers using algorithms based on a table, such as Table 1 of Poyser. In Poyser, data is

collected and compared to data values that have been previously stored (e.g., in the table). A previously defined action is then taken responsive to the comparison. In Poyser, the test sequences are fixed, and the results of all of the tests are taken in conjunction with each other to determine what action should next be taken. Therefore, in Poyser, the sequence of testing is not user-changeable, an order of execution is not user-definable, and the user cannot select which tests and methods he would like in the test sequence. In fact, it is submitted that Poyser teaches away from the present invention.

Moreover, it is respectfully submitted that the type and sequence of the tests described in Poyser are not inherently customizable by a user. Poyser merely provides a table of multiple conditions that, when taken together, dictate subsequent system actions. For example, if the top oil temperature is above a certain temperature, and the hot spot temperature is less than a certain temperature and other conditions are met, then a first process is performed; otherwise, another process, suitable for the conditions, is performed, pursuant to the programmed table. It does not necessarily follow that a user would be provided with the ability to change the test sequence, the tests in the sequence, or the order of execution of the tests. For example, in Poyser, there is absolutely no reason given or contemplated why one would want to measure the top oil temperature before the hot spot temperature or vice versa. There is no teaching or suggestion, and it is clearly not inherent, of a user-changeable transformer test sequence, nor a user-defined order of execution of user-selected tests and instructions, as required by claim 1.

The Examiner cites MPEP 2106, *Dann v. Johnston*, and *In re Venner* as support. It is respectfully submitted that MPEP 2106, *Dann v. Johnston*, and *In re Venner* do not apply in this case. MPEP 2106 is directed to computer-related inventions and the determination of whether the claimed invention complies with 35 U.S.C. §§ 102 and 103. MPEP 2106 states that merely using a computer to automate a known process does not by itself impart nonobviousness to the invention. However, as described above, Applicant's invention is not merely automating a known process; instead, Applicant's invention is directed to a new process itself along with a corresponding system.

Dann v. Johnston was directed to a "machine system" for automatic record keeping of bank checks, in which business methods that bankers had always used on paper in the past

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were now put into a computer implemented system. The Court held that such an invention was obvious, but it was in the context of automating a known process. Similarly, *In re Venner* stands for the proposition that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. However, as set forth above, Applicant's invention is directed to a new process (along with a corresponding system) and not merely the automation of a known process.

Claims 7, 13, 18, and 23 recite similar features as those set forth above with respect to claim 1. Based on the foregoing, claims 1, 7, 13, 18, and 23 and all claims dependent therefrom, including claims 2-6, 8-12, 14-16, 19-21, and 24-26, respectively, should not be rejected as being unpatentable over Poyser et al. Thus, claims 1-16, 18-21, and 23-26 are patentable for the reasons set forth above. Withdrawal of the rejections of claims 1-16, 18-21, and 23-26 under 35 U.S.C. § 103(a) is respectfully requested.

In view of the above remarks, Applicants respectfully submit that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested.

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